

REMARKS

Claims 17-19, 21, 22 and 29-34 are pending. Claims 17-19, 21 and 22 stand withdrawn. Applicants request that upon allowance of claim 29 that claims 17-19, 21 and 22 be recombined with examined claims 29-31. Claims 29 and 34 are currently amended. No new matter has been added. The amendments to claims 29 and 34 do not raise new issues that require further consideration or search. For example, the term “discrete” has been inserted at line 9 of claim 29. This limitation has been considered in the Final Office Action at page 3. The phrase “the side surface” has been changed to “said opposing side surface” in response to PTO observations under § 112. The amendment to claim 34 is formal in nature and corrects a misspelled word. Entry and reconsideration of the above Amendment and remarks herein are requested.

Response to PTO § 112 Observations

The Office Action rejects claims 29-34 under 35 U.S.C. 112, second paragraph, because the phrase “protruding from the side surface” at line 12 of claim 29 is allegedly indefinite. Applicants have amended claim 29 to now recite “protruding from said *opposing* side surface.” In view of the above Amendment, the rejection should now be moot.

Response to PTO § 103 Arguments

Claims 29, 31-32, and 34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Herzberg (U.S. Patent No. 4,988,350) in view of Sioufi (U.S. Patent No. 5,409,489). Applicants traverse the rejection.

The Office Action initially discusses the teaching of the Herzberg patent:

Herzberg [] discloses an implant plate [with] at least one receiving member (129) protruding from the plate (Fig. 18, 129), that is located on the head portion and is considered proximate to the edge. Flexible members such as cerclage wires may be passed through these

receiving members and then tightened to assist in securing the bone plate to the bone surface for fixation.

The Office Action then expressly acknowledges Herzberg fails to teach or suggest, *i.e.*, “discrete, circumferentially enclosed apertures that extend from the bone plate for securing flexible members.” (Office Action, page 3). These deficiencies are allegedly remedied by the Sioufi patent. The Office Action posits that modifying the cut-outs of Herzberg to be closed, in a manner like the stabilizing hook receiving eyelets 88 of Sioufi “would ensure that the flexible members used to secure the plate do not more (sic: move) or become dislocated.”

One of ordinary skill in the art would recognize that the cut-outs of Herzberg are more akin to depressions than “protrusions.” Further, as acknowledged by the PTO, the “cut-outs” are not discrete. Herzberg makes clear that bent-over sections 126', 126", each encompassing multiple cut-outs, are contiguous with and an integral part of plate 25 (9/45-56):

Said connecting device 70 consists of a bending or folding over of the circumferential edge 125 of the plate-shaped and spoon-like constructed section 25 of the trochanter supporting plate 20 within the rearward area of the latter. This bent-over circumferential section 126 is constructed essentially within the central lateral areas 125a, 125b of the circumferential edge 125 of the section 25 and thus extends to both sides of the section 25 of the trochanter supporting plate 20, so that two individual sections 126', 126" are formed. The ends of the two individual areas 126', 126" taper conically on both sides (FIG. 17).

To make the cut-outs of Herzberg “discrete” would require elimination or complete redesign of Herzberg’s “bent-over circumferential section 126,” and therefore impermissible restructuring of Herzberg’s spoon shaped plate design. *See In re Ratti*, 270 F.2d 810, 812 (CCPA 1959) (We hold, further, that the combination of Jepson with Chinnery et al. is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in Chinnery et al. as well as a change in the basic principles under which the Chinnery et al. construction was designed to

operate.) Further, to the extent that the PTO Office Action contemplates merely closing off the top of the cut-out, the continuity of the edge profile would be changed without any apparent benefit.

Further, as stated above, the Office Action posits,

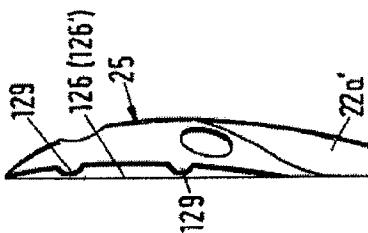
Herzberg discloses the claimed invention except for discrete, circumferentially enclosed apertures that extend from the bone plate for securing flexible members. Sioufi discloses a plate with a head and shaft portion that also has circumferentially enclosed apertures (88) extending from the side of the plate at the head end. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Herzberg having the receiving member replaced with circumferentially enclosed apertures as taught by Sioufi, as doing so would ensure that the flexible members used to secure the plate do (sic: to) not move (sic: move) or become dislocated.

Although the Office Action conjectures why the cut-out could be modified, Applicants can find no teaching in Herzberg that could convey to one of ordinary skill in the art that Herzberg's structure is deficient in any way to warrant the redesign proposed by the PTO. This is especially so since the proposed modification would complicate the manufacturing technique contemplated by Herzberg, and possibly also complicate the method of using the plate, without any real benefit. The alleged reason is to better "secure" the plate or prevent its dislocation. Any benefit that may be provided does not seem to outweigh the negative impact of the proposed modifications. There is clearly no sufficient articulated reason to justify the suggested modification. *See KSR Int'l Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, 1741 (April 30, 2007):

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness).

More specifically, Herzberg simply cuts out edge material from the spoon shaped plate material, and then bends opposing edges. Herzberg merely lays the cerclage wire in an edge depression. The Office Action's proposed redesign replaces cut-outs ("edge depressions") with

closed eyelets. Forming circumferentially enclosed openings in edge 126, which is formed from a spoon shaped plate material, would require that the height of the edge 126 double in size, as the illustrated cut-out does not even appear to be a full semi-circle. Figure 18 below shows a side view of the spoon shaped plate:



The Office Action provides no articulated reason why one of ordinary skill in the art would make this modification.

The proposed redesign would complicate the manufacturing technique by now requiring formation of a more complex plate edge. The Office Action provides no articulated reason why one of ordinary skill in the art would do this.

The proposed change would likely alter the profile of edges 126 of the Herzberg plate. The Office Action provides no articulated reason why one of ordinary skill in the art would do this.

Replacing the edge depressions of Herzberg with closed eyelets would require threading a wire through an opening in contrast to simply laying a wire in a depression. The procedure would likely be more time consuming and more complicated. The Office Action provides no articulated reason why one of ordinary skill in the art would want to prolong and complicate a medical procedure.

For reasons given above, the rejection of claims 29, 31-32, and 34 is improper and should be withdrawn. As for claims 30 and 33, each depends from patentable claim 29, as discussed above, and therefore PTO arguments concerning these claims are moot.

Accordingly, the rejections of record are improper and should be withdrawn. In view of the above amendment, Applicants submit the pending application is in condition for allowance.

Application No. 10/635,919
Amendment dated October 20, 2009
Reply to July 21, 2009 Final Office Action

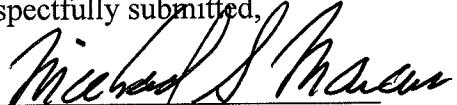
Docket No.: A8130.0659/P659

Authorization

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1073, under Order No. A8130.0659/P659.

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Respectfully submitted,

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